



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q65593

Hubert HELAINE, et al.

Appln. No.: 09/918,501

Group Art Unit: 2617

Confirmation No.: 3234

Examiner: Morcos L. Torres

Filed: August 1, 2001

For: AUTOMATIC METHOD OF MANAGING NETWORK SERVICES

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notice of Non-Compliant Appeal Brief dated September 27, please consider the following remarks:

The Notice of Non-Compliant Appeal Brief alleges that the Appeal Brief does not contain the items required under 37 C.F.R. § 41.37(c), or the items are not under the proper heading, or in the proper order. The Notice of Non-Compliant Appeal Brief also alleges that the independent claims are not explicitly identified and are not mapped to the specification by page and line number, paragraph number, or to the drawings.

Applicant submits that the Notice of Non-Compliant Appeal Brief is unwarranted since the Appeal Brief is complete and sufficient under the rules of the United States Patent and Trademark

Response to Notice of Non-Compliant Amendment
U.S. Appln. No.: 09/918,501

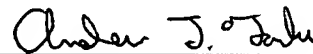
Group Art Unit 2617
Attorney Docket #: Q65593

Office. First, Applicant notes that the Appeal Brief contains all of the items required under 37 C.F.R. § 41.37(c), the items are under the proper heading, and the items are in the proper order.

Second, Applicant notes that the independent claims 1, 15 and 16 are explicitly identified on pages 8-9 of the Appeal Brief. Further, the Appeal Brief discusses several exemplary embodiments of the present invention (page 8, lines 6-14), explicitly relates this discussion to the independent claims 1, 15 and 16 (page 8, lines 15-16), and explicitly maps this discussion to the specification by page number (page 6, lines 5-11). As such, Applicant submits that the Notice of Non-Compliant Appeal Brief is unwarranted for *at least* these reasons.

Nevertheless, in an effort to expedite prosecution of this matter, Applicant has submitted herewith an Amended Appeal Brief under 37 C.F.R. § 41.37 that even more explicitly identifies the independent claims and even more explicitly maps them to the specification by page and line number. Entry and consideration of the enclosed Amended Appeal Brief is respectfully requested.

Respectfully submitted,



Andrew J. Taska
Registration No. 54,666

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: October 27, 2006



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q65593

Hubert HELAINE, et al.

Appln. No.: 09/918,501

Group Art Unit: 2617

Confirmation No.: 3234

Examiner: Morcos L. Torres

Filed: August 1, 2001

For: AUTOMATIC METHOD OF MANAGING NETWORK SERVICES

AMENDED APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

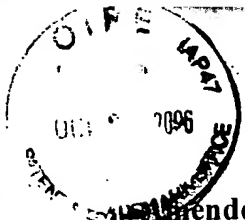
Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I.	REAL PARTY IN INTEREST.....	3
II.	RELATED APPEALS AND INTERFERENCES	4
III.	STATUS OF CLAIMS.....	5
IV.	STATUS OF AMENDMENTS.....	6
V.	SUMMARY OF THE CLAIMED SUBJECT MATTER	7
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	14

VII. ARGUMENT.....	15
CLAIMS APPENDIX	31
EVIDENCE APPENDIX:	35
RELATED PROCEEDINGS APPENDIX.....	36



Amended Appeal Brief under 37 C.F.R. § 41.37
U.S. Appln. No.: 09/918,501

Group Art Unit 2617
Attorney Docket #: Q65593



I. REAL PARTY IN INTEREST

The real party of interest is Alcatel, of Paris, France, by virtue of an assignment executed by Hubert Helaine on July 15, 2001 and France Dervaux on July 13, 2001. The assignment was recorded on August 1, 2001, at Reel 012051, Frame 0775.



II. RELATED APPEALS AND INTERFERENCES

To the best of the knowledge and belief of Appellant, Appellant's legal representatives, and the assignee in this application, there are no other pending appeals or interferences before the Board of Appeals and Interferences (hereinafter "the Board") that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant Appeal.



Amended Appeal Brief under 37 C.F.R. § 41.37
U.S. Appln. No.: 09/918,501

Group Art Unit 2617
Attorney Docket #: Q65593

III. STATUS OF CLAIMS

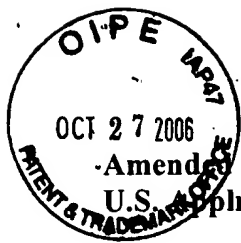
Claims 1-16 are all of the claims currently pending in the present application. Currently, claims 1-16 stand rejected by the Examiner, and are the subject of this Appeal.

Amended Appeal Brief under 37 C.F.R. § 41.37
U.S. Appl. No.: 09/918,501

Group Art Unit 2617
Attorney Docket #: Q65593

IV. STATUS OF AMENDMENTS

A Response under 37 C.F.R. § 1.116 was filed on June 9, 2006, in response to the Office Action dated March 9, 2006. There are no outstanding, non-entered amendments of the claims.



V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's invention relates to a method for automatically managing network services. More particularly, Appellant's invention relates to a method for enabling a user who subscribes to a mobile telephone service and to a landline telephone service to access the associated services in a totally transparent manner such that the user can access the terrestrial network or the mobile network from the same handset or terminal in exactly the same way. As a matter of example to more fully explain the invention, Appellant will describe the features shown in the exemplary embodiments of the invention, which are described in detail on pages 4-12 of the Specification. Portions of the claims that correspond to the features shown in the exemplary embodiments are also referenced during this discussion. However, this discussion of the exemplary embodiments and the pending claims is provided for explanatory purposes only, and is not intended to limit the scope of the claims in any way.

Conventional terrestrial telephone networks and mobile telephone networks offer a variety of different services to users. Such services may include, for instance, call forwarding, call barring, voicemail, etc., and can be accessed using a terminal connected to the respective network. And, such services can be accessed, for example, by pressing a sequence of keys on the keypad of a terminal, or by entering an access code.

While many terrestrial telephone networks and mobile telephone networks offer different services to users, the services offered are not necessarily identical, and even if the offered services are identical, the services are not necessarily accessed in the same manner.

Accordingly, a user of a terrestrial telephone network must know the procedures for accessing

the terrestrial network services and the procedures or access codes for accessing the mobile telephone network services.

Generally speaking, access procedures consist of typing in numerical codes which are not easy to memorize. Not to mention that, in order to utilize both a terrestrial telephone network and a mobile telephone network, users must purchase two different terminals, a terrestrial telephone network terminal and a mobile telephone network terminal.

Conventional terminals have been developed which enable a user to make calls via both a terrestrial telephone network and a mobile telephone network, which constitutes an alternative to purchasing two different terminals. However, such terminals are expensive because they consist of a combination of a terrestrial telephone network terminal and a mobile telephone network terminal, which are in the same housing. Furthermore, such conventional terminals do not do away with the need for a user to memorize the procedures for accessing the services offered by the terrestrial telephone network and for accessing the services offered by the mobile telephone network, respectively.

One illustrative and non-limiting embodiment of the present invention addresses the above problems by connecting a mobile telephone to a private base that is itself connected to the network of a terrestrial telephone operator, for example, to a public switched telephone network. According to this exemplary embodiment, the mobile telephone and the private base are connected in a manner that is specific to the mobile telephone.

By way of illustration, in one selected mode of operation, the mobile telephone automatically connects to the private base that belongs to a terrestrial telephone network as soon

as the mobile telephone is within range of the private base. On the other hand, when the mobile telephone is no longer within range of the private base, the mobile telephone automatically disconnects from the private base and reconnects to the mobile telephone network immediately. Moreover, when the mobile telephone is connected to the private base, the mobile telephone behaves like an access terminal to the terrestrial telephone network.

Therefore, according to an exemplary embodiment of the present invention, a user of the mobile telephone who wants to access services of either the mobile telephone network or the terrestrial telephone network can do so using the same interface, namely, the mobile telephone. In particular, if a user requests access services and the mobile telephone is connected to the private base at the time, then the mobile telephone sends the service request to the private base. The private base, in turn, converts the service request into a format of the terrestrial telephone network and then transmits the converted request to the terrestrial telephone network operator. According to one exemplary embodiment, this change in format is effected by means of a memory, which may store, for instance, a conversion table.

A central issue on this appeal involves the distinction between a private base and a public base station of a mobile telephone network. A person of ordinary skill in the art would readily discern that a private base is just that—a base which is configured for the private use of a respective terminal or terminals.

As made clear in the present specification, a private base is completely different than a base station of a public mobile telephone network, which is configured for use by the general public. (*See e.g.*, page 5, lines 1-3). Indeed, the specification describes that a private base and a

base station of a public mobile telephone network are completely different devices, with completely different structures and different functions.

For instance, the present specification describes that the range of a private base is generally restricted compared to the range of a base station of a public mobile telephone network. Further, the specification describes an exemplary embodiment of the present invention wherein the range of a private base 102 is restricted to a few hundred meters and, as a result, is not picked up by the base stations of a public mobile telephone network. (Page 5, lines 1-3). In contrast, the range of a base station of a public mobile telephone network provides a much wider coverage area relative to private bases, so as to facilitate access to the public in a cell which may extend over several miles.

In short, private bases are configured in an entirely different manner than public base stations of mobile telephone networks and private bases perform fundamentally different operations. Put simply, whereas private bases are configured for private use by an individual, public base stations of mobile telephone networks are configured for public use by the public at large.

A. Identification of Independent Claims

The above discussion relates to exemplary embodiments, but also to the more generally-expressed claim language of independent claims 1, 15 and 16 below:

1. (previously presented): An automatic
network services management method comprising:
connecting a communication terminal of a
first network to a private base;

connecting said private base to a second network; and

a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network.

15. (previously presented): A communication terminal, adapted to implement an automatic network services management method, comprising:

a communication terminal of a first network;

a private base connected to a second network, wherein said communication terminal is connected to said private base; and

a memory structured to establish a correspondence between service codes of said first network and service codes of said second network.

16. (previously presented): A private base, adapted to implement an automatic network services management method, comprising:

a communication terminal of a first network;

a private base connected to a second network, wherein said communication terminal is connected to said private base; and

a memory structured to establish a correspondence between service codes of said first network and service codes of said second network.

B. Mapping of Generally Expressed Claim Language of Independent Claims to Specification by Page and Line Number

Claim 1:

An automatic network services management method is provided. (*See e.g.*, page 4, lines 1- 6; page 7, line 16 – page 12, line 30; Figures 1-2). The method comprises connecting a communication terminal of a first network to a private base. (*See e.g.*, page 4, line 3; page 4, line 21 – page 6, line 11; page 7, line 32 – page 8, line 15; Figures 1-2). The method further comprises connecting said private base to a second network. (*See e.g.*, page 4, line 4; page 4, line 29 – page 5, line 3; page 5, line 32 – page 6, line 22; page 7, lines 16-31; page 11, lines 4-30; Figures 1-2). The method also comprises a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network. (*See e.g.*, page 4, lines 5-6; page 5, line 32 – page 7, line 12; page 8, line 16 – page 12, line 30; Figures 1-2).

Claim 15:

A communication terminal, adapted to implement an automatic network services management method is provided. (*See e.g.*, page 4, lines 1- 6; page 7, line 16 – page 12, line 30; Figures 1-2). A communication terminal of a first network is also provided. (*See e.g.*, page 4, line 3; page 4, line 21 – page 6, line 11; page 7, line 32 – page 8, line 15; Figures 1-2). Moreover, a private base is provided which is connected to a second network, wherein said communication terminal is connected to said private base. (*See e.g.*, page 4, line 4; page 4, line 29 – page 5, line 3; page 5, line 32 – page 6, line 22; page 7, lines 16-31; page 11, lines 4-30;

Figures 1-2). A memory is also provided which is structured to establish a correspondence between service codes of said first network and service codes of said second network. (*See e.g.*, page 4, lines 5-6; page 5, line 32 – page 7, line 12; page 8, line 16 – page 12, line 30; Figures 1-2).

Claim 16:

A private base is provided which is adapted to implement an automatic network services management method. (*See e.g.*, page 4, lines 1- 6; page 7, line 16 – page 12, line 30; Figures 1-2). Also provided is a communication terminal of a first network. (*See e.g.*, page 4, line 3; page 4, line 21 – page 6, line 11; page 7, line 32 – page 8, line 15; Figures 1-2). A private base is provided which connected to a second network, wherein said communication terminal is connected to said private base. (*See e.g.*, page 4, line 4; page 4, line 29 – page 5, line 3; page 5, line 32 – page 6, line 22; page 7, lines 16-31; page 11, lines 4-30; Figures 1-2). Additionally, a memory is provided which is structured to establish a correspondence between service codes of said first network and service codes of said second network. (*See e.g.*, page 4, lines 5-6; page 5, line 32 – page 7, line 12; page 8, line 16 – page 12, line 30; Figures 1-2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (1) Whether or not claims 1-2, 9 and 12-16 are unpatentable under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,029,065 to Shah (hereinafter “Shah”), and in view of U.S. Patent No. 5,745,852 to Khan *et al.* (hereinafter “Khan”).
- (2) Whether or not claim 3 is unpatentable under 35 U.S.C. § 103(a) in view of Shah, in view of Khan, and further in view of European Patent Application No. EP 0 748 136 to Sipilä (hereinafter “Sipilä”).
- (3) Whether or not claims 4 and 6-7 are unpatentable under 35 U.S.C. § 103(a) in view of Shah, in view of Khan, in view of Sipilä, and further in view of U.S. Patent No. 6,434,399 to Kasmperschroer (hereinafter “Kasmperschroer”).
- (4) Whether or not claim 5 is unpatentable under 35 U.S.C. § 103(a) in view of Shah, in view of Khan, in view of Sipilä, in view of Kasmperschroer, and further in view of U.S. Patent No. 5,924,014 to Heuvel *et al.* (hereinafter “Heuvel”).
- (5) Whether or not claims 8-11 are unpatentable under 35 U.S.C. § 103(a) in view of Shah, in view of Khan, and further in view of Kasmperschroer.

VII. ARGUMENT

A. Claim Rejections under 35 U.S.C. §103 – Shah in view of Kahn

As discussed above, the Examiner has rejected claims 1-2, 9 and 12-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,029,065 to Shah (hereinafter “Shah”), and in view of U.S. Patent No. 5,745,852 to Khan et al. (hereinafter “Khan”).

1. Independent Claim 1

Shah teaches a method of programming network feature codes in mobile stations. (col. 1, lines 5-7). As taught in Shah, a local base station of a public mobile telephone network determines what features a visiting mobile telephone of a public user supports, and then provides the feature codes to the visiting mobile telephone that are required to access the network features. (*See e.g.*, Abstract).

On the other hand, Kahn teaches that a private land-line supported base station supports the registering of multiple local mobile telephones of a private user and provides a personalized call delivery feature for each registered mobile station of a private user. (*See e.g.*, Abstract).

In contrast the teachings of Shah and Kahn, independent claim 1 requires (among other things):

...connecting a communication terminal of a first network to a private base;

connecting said private base to a second network; and

a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network.

The Examiner acknowledges that Shah fails to teach or suggest the feature of connecting a communication terminal of a first network to a private base, as recited in claim 1. (08/25/05 Office Action, page 2). Appellant agrees with the Examiner that Shah fails to teach or suggest this feature.

Nevertheless, the Examiner alleges that Shah teaches connecting a Mobile Station 100 to a public Base Station 200. On the other hand, the Examiner alleges that Khan teaches that a mobile station 10 is connected to a private base station 20, thereby enabling the connection of the mobile station 10 with the network of the private base station 20. (08/25/05 Office Action, page 3). The Office Action also alleges that it would have been obvious to one of ordinary skill in the art to combine the teachings of Shah and Khan, and to modify the resultant combination to arrive at the recitations in claim 1. Further, the Examiner alleges that one of ordinary skill in the art would have been motivated to do so “for the simple purpose of permitting the user to take advantage of the reduced call cost of the private base.” (08/25/05 Office Action, page 3). The Examiner also alleges that one of ordinary skill would have been motivated to combine the teachings of Shah and Kahn “to extend the features coverage.” (03/09/06 Office Action, page 2).

Appellant disagrees. First, Appellant submits that the Examiner has failed to establish even a *prima facie* case of obviousness because the Examiner has failed to provide a proper motivation to combine the cited references in the specific manner of Appellant’s claimed invention. Indeed, MPEP § 2143 requires that, to establish a *prima facie* case of obviousness, the Examiner must establish that there is some suggestion or motivation, in either the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings.

The first alleged motivation for combining the disparate teachings of Shah and Kahn asserted by the Examiner is “for permitting the user to take advantage of the reduced call cost of the private base.” (08/25/05 Office Action, page 3). However, none of the previous Office Actions point to any specific portion of the cited references to support such an alleged motivation to combine the reference teachings. In fact, none of the previous Office Actions have provided any evidentiary support whatsoever for this alleged motivation.

It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). And, this burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. (*In re Lahu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984)). Indeed, unsupported statements and conclusions of obviousness are considered inadmissible hindsight. (*See, e.g., In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987), *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987), *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), *Ex parte Clapp*, 227 USPQ 972 (Pat. Off. Bd. App. & Inter. 1985), *Ex parte Shepard and Gushue*, 188 USPQ 537 (Pat. Off. Bd. App. 1974)).

However, the Examiner has repeatedly failed to provide any response whatsoever to Appellant’s arguments that no evidentiary support has been provided for the assertion that a skilled artisan would have been motivated to combine and modify the cited references “for the simple purpose of permitting the user to take advantage of the reduced call cost of the private

base.” To the contrary, the 03/09/06 Office Action completely ignored such arguments by stating that “in addition to the motivation already presented...” and then proceeding to cite an additional unsupported motivation to combine the reference teachings, without providing any evidence to support to originally cited motivation to combine.

Since the Examiner has not provided any evidentiary support whatsoever to support the bald allegation that a skilled artisan would have been motivated to combine the teachings of Shah and Khan “for permitting the user to take advantage of the reduced call cost of the private base,” the Examiner has failed to establish even a *prima facie* case of obviousness and Appellant respectfully requests that the Board overturn the Examiner’s rejections for *at least* these independent reasons.

The second alleged motivation to combine the teachings of Shah and Kahn asserted by the Examiner is “to extend the features coverage.” (03/09/06 Office Action, page 2). However, the Examiner has also failed to provide the requisite evidentiary support for this second alleged motivation to combine the cited references.

In fact, the Examiner has failed to provide any proper evidentiary support whatsoever for the assertion that a skilled artisan would have been motivated to combine and modify the teachings of Shah and Kahn “to extend the features coverage.” The Examiner merely alleges that Shah is concerned with offering features to a mobile station and that Kahn is concerned with offering features to a mobile station. Thus, the Examiner summarily alleges that since both Shah and Kahn are analogous and concerned with the same problem, it would have been obvious to a skilled artisan to combine both references.

Appellant disagrees. The evidence relied upon by the Examiner clearly does not support the Examiner's position. For instance, the Examiner cites column 1, lines 66 – column 2, line 1 of Kahn, for the proposition that Kahn is concerned with offering features to a mobile station. However, column 1, lines 66 – column 2, line 1 of Kahn states, "...clearly understood from the following detailed description when read with the appended drawing in which: FIG. 1 shows a simplified block diagram of a cellular..." (Column 1, lines 66 – column 2, line 1). Therefore, column 1, lines 66 – column 2, line 1 of Kahn is completely irrelevant to the Examiner's position.

Further, to support the Examiner's arguments that Kahn is directed to offering intelligent features to a mobile station (and is not directed to a land-line supported private base station as alleged by Appellant) the Examiner relies on the title of the Kahn reference, alleging that the first four words recite "System for providing features." Once again, the Examiner's position is unsupported. In fact, the citations provided by the Examiner irrefutably support Appellant's position.

Specifically, the title of Kahn reads in full, "Land-Line Supported Private Base Station Operable in a Cellular System." (Title). Therefore, Kahn explicitly states in the title thereof that Kahn is directed to a land-line supported private base station, as alleged by Appellant. And, the first four words of Kahn's title clearly do not recite "System for providing features," as alleged by the Examiner.

Therefore, Appellant submits that the Examiner also fails to provide proper evidentiary support for the Examiner's second alleged motivation to combine the cited references (i.e., "to extend the features coverage"). Further, contrary to the Examiner's allegations, Shah and Kahn are each directed to vastly different problems. As evidenced from their respective titles, Shah is plainly directed to programming feature codes for visiting mobile stations. In contrast, Khan is directed to the entirely unrelated problem of providing a land-line supported base station that is operable in a cellular system.

As such, Appellant respectfully requests that the Board overturn the Examiner's rejections for *at least* these independent reasons.

Second, Appellant submits that the grounds of rejection also fail because one of ordinary skill in the art would not have been motivated to combine the teachings of Shah and Khan in the manner proposed by the Examiner to arrive at the recitations in claim 1. Indeed, the Examiner has not identified any specific teaching or suggestion regarding the desirability of combining Shah's means for facilitating a visiting mobile station's access of a public user to a visited public network via a visited public base station, with the completely unrelated private base station taught in Khan, to arrive at the invention recited in claim 1.

It is well-settled that most if not all inventions arise from a combination of old elements. (*In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998))). Thus, every element of a claimed invention may often be found in the prior art. (*Id.*) However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. (*Id.*) Rather, to establish

obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Appellant. (*In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984))).

Here, the Examiner alleges that it would have been obvious to one of ordinary skill to combine the teachings of Shah, regarding connecting a visiting Mobile Station 100 of a public user to a public Base Station 200 and converting a first set of feature codes recognized by the public Base Station 200 to a second set of feature codes recognized by the visiting Mobile Station 100 of a public user, with the teachings of Kahn that a mobile station 10 of a private user is connected to a private base station 20, to arrive at the invention recited in claim 1. (08/25/05 Office Action, page 3). Appellant respectfully disagrees.

The fundamental objective of Shah is to provide a method for remote feature code programming and conversion for a visiting mobile station of a public user (i.e., a mobile station of a user from the public at large, which is accessing a public base station, rather than the mobile station's home network). (Column 3, lines 25-53). Therefore, Shah is directed to providing a user-transparent means for a visiting mobile public user to access a visited public network connected to a visited public base station, without requiring knowledge of the visited public network's specific feature codes. (Column 3, lines 16-19). That is, Shah is directed to a means for facilitating the network access of a visiting mobile station of a public user, as the visiting

mobile station of the public user moves from the coverage area of a home public base station to the coverage area of a visited public base station.

Since Shah is directed to a means for facilitating access of a visiting mobile station of a public user to a visited network via a visited public base station, Appellant submits that one of ordinary skill in the art would not have been motivated to look toward the disparate teachings of Khan, which is directed to the entirely different operation of registering a mobile station of a private user with a private base station connected to a private land-line subscriber telephone (i.e., a home private base station).

In fact, Khan specifically teaches away from such a proposed combination, in that, Khan teaches that private base stations operate at a greatly reduced power level than the public base stations of large cells. (Column 1, lines 22-23). As such, Khan teaches that such private base stations would not be suitable for providing access to visiting mobile stations of the public at large, as taught in Shah.

Indeed, as taught in Kahn, private base stations are exactly that—private—and do not permit access to the visiting public. As such, since Kahn's teachings are directed toward private base stations which operate at reduced power to prevent access from the public at large, Appellant submits that a skilled artisan would not have been motivated to look toward Kahn for guidance as to how to improve the wholly unrelated public base stations taught in Shah.

Accordingly, Appellant submits that the Examiner has failed to identify any specific suggestion or teaching of the desirability of combining the means for facilitating access of a visiting mobile station of a public user to a visited network via a visited public base station, as

taught in Shah, with the private base station taught in Khan, to arrive at the invention recited in claim 1. To the contrary, Khan explicitly teaches away from the Office Action's proposed combination.

In response to Appellant's arguments to this effect, the Examiner merely asserts that Kahn does not teach away from the proposed modification because Appellant's arguments "refer[ing] to the description of prior art without considering Kahn's improvements." More particularly, the Examiner alleges that col. 1, lines 48-52 of Kahn teaches multiple mobile stations registering to use the private base station. (03/09/06 Office Action, p. [insert cite]).

However, Appellant submits that even considering Kahn's purported improvement of the "assignment of a local unique address for each one of the multiple mobile stations registering with the private base station," Kahn still expressly teaches away from combining the teachings of Shah and Kahn. In addition to Khan's teaching that conventional private base stations operate at a greatly reduced power level than the public base stations of large cells, like those taught in Shah,¹ Khan explicitly teaches that the private base station 20, disclosed therein, "is limited to a very low level of transmitted power for restricting its coverage range to a relatively small area." (Column 3, lines 46-48). Thus, Khan makes it clear that the private base stations taught therein are specifically tailored for private use within a relatively small area, in stark contrast to the high-power public base stations, like those taught in Shah, which have a coverage range extending over an extremely large area.

¹ (Col. 1, lines 22-23).

Furthermore, Khan teaches that each private station is connected to a user's private land-line subscriber telephone number, a fact which expressly teaches away from the notion of applying the teachings of such private bases to provide access to the public. (See col. 1, lines 23-25). Kahn also fails to provide any suggestion that the private mobile stations taught therein would ever visit any other base station and, thus, the teachings of Shah are entirely unrelated to those of Kahn.

Therefore, even assuming *arguendo* that Kahn teaches that multiple private mobile stations may register to use the local low-power private base station taught therein, as alleged in the grounds of rejection, no aspect of Kahn suggests the desirability of applying the teachings regarding Kahn's low-power private base station to the completely different public base stations of large cells providing access to the public at large, as taught in Shah, which operate at a greatly increased power level. In fact, Khan clearly teaches away from such a proposed modification since Kahn's private base station is specifically tailored for short-range private operation and is entirely unsuitable for facilitating public access to Shah's visiting mobile stations.

Accordingly, Kahn clearly teaches away from the notion of combining Shah's means for facilitating a visiting mobile station's access to a visited network via a visited public base station, with the private base station taught in Khan. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections for *at least* these reasons.

What is more, even if the Examiner's assertions were true that the cited Shah and Khan references are from analogous arts and are concerned with the same problem (which Appellant's firmly submits they are not), the Examiner has nevertheless failed to identify any motivation, in

either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. (*See* MPEP § 2143.)

In response to Appellant's arguments that Kahn teaches away from the Examiner's proposed combination since Kahn's base station operates at reduced power level, the Examiner alleges that the features upon which Appellant relies are not recited in the rejected claims. (06/21/06 Office Action, p. 2). However, Appellant notes that the previous arguments to which the Examiner refers in this assertion were solely directed to rebutting the Examiner's arguments that it would have been obvious to combine the teachings of Shah and Kahn. In particular, Appellant's arguments in this regard addressed the narrow issue of how Kahn teaches away from combining the teachings of Kahn with those of Shah. Therefore, the Examiner's contention that the features upon which Appellant relies to support Appellant's arguments that Kahn teaches away, are not recited in the rejected claims, is completely irrelevant to a proper determination of whether or not Kahn teaches away from the Examiner's proposed combination under 35 U.S.C. § 103.

Finally, in response to the Examiner's contention that certain features relied upon by Appellant (e.g., private landline, facilitating public access) are not recited in the pending claims, Appellant notes that none of Appellant's previous arguments allege that the features of a private landline or facilitating public access are recited in any of the pending claims. Moreover, none of Appellant's previous arguments allege that the features of a private landline or facilitating public access are not shown by the cited references. Therefore, the Examiner's contentions in this regard are entirely irrelevant to a proper obviousness determination under 35 U.S.C. § 103.

Accordingly, Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 1 for *at least* these reasons. Further, Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claims 2, 9 and 12-14, *at least* by virtue of their dependency on claim 1.

2. Independent Claim 15

In view of the similarity between the recitations of claim 15 and the recitations discussed above with respect to independent claim 1, Appellant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 15. As such, it is respectfully submitted that claim 15 is patentably distinguishable over the cited Shah and Khan references *at least* for reasons analogous to those presented above. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 15 for *at least* these reasons.

3. Independent Claim 16

In view of the similarity between the recitations of claim 16 and the recitations discussed above with respect to independent claim 1, Appellant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 16. As such, it is respectfully submitted that claim 16 is patentably distinguishable over the cited Shah and Khan references *at least* for reasons analogous to those presented above. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 16 for *at least* these reasons.

B. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Khan and further in view of Sipilä

The Examiner has rejected claim 3 as being unpatentable over Shah, in view of Khan, and further in view of European Patent Application No. EP 0 748 136 to Sipilä (hereinafter “Sipilä”). Appellant respectfully requests that the Board overturn the Examiner’s rejections with respect to claim 3 for *at least* the independent reasons stated below.

Claim 3 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, the Examiner has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Examiner. Moreover, Sipilä also fails to remedy these deficiencies. Therefore, Appellant respectfully submits that claim 3 is patentable over Shah, Kahn, Sipilä, and any combination thereof, for *at least* these independent reasons. Thus, Appellant respectfully requests that the Board overturn the Examiner’s rejection of claim 3.

C. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Sipilä, and further in view of Kasmperschroer

The Examiner has rejected claims 4 and 6-7 as being unpatentable over Shah, in view of Khan, in view of Sipilä, and further in view of U.S. Patent No. 6,434,399 to Kasmperschroer (hereinafter “Kasmperschroer”). Appellant respectfully requests that the Board overturn the Examiner’s rejections with respect to claims 4 and 6-7 for *at least* the independent reasons stated below.

Claims 4 and 6-7 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, the Examiner has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Examiner. In addition, both Sipilä and Kasmperschroer also fail to remedy these deficiencies. Hence, Appellant respectfully submits that claims 4 and 6-7 are patentable over Shah, Kahn, Sipilä, Kasmperschroer, and any combination thereof, for *at least* these independent reasons. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections of claims 4 and 6-7.

D. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Sipilä, further in view of Kasmperschroer, and further in view of Heuvel

The Examiner has rejected claim 5 as being unpatentable over Shah, in view of Khan, in view of Sipilä, in view of Kasmperschroer, and further in view of U.S. Patent No. 5,924,014 to Heuvel *et al.* (hereinafter "Heuvel"). Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claim 5 for *at least* the independent reasons stated below.

Claim 5 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, the Examiner has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Examiner. Moreover, Sipilä, Kasmperschroer, and Heuvel all fail to remedy these deficiencies. Therefore, Appellant respectfully submits that

claim 5 is patentable over Shah, Kahn, Sipilä, Kasmperschroer, Heuvel and any combination thereof, for *at least* these independent reasons. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejection of claim 5.

E. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Kasmperschroer

The Examiner has rejected claims 8-11 as being unpatentable over Shah, in view of Khan, and further in view of Kasmperschroer. Appellant respectfully requests that the Board overturn the Examiner's rejections with respect to claims 8-11 for *at least* the independent reasons stated below.

Claims 8-11 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, the Examiner has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Examiner. Moreover, Kasmperschroer also fails to remedy these deficiencies. Therefore, Appellant respectfully submits that claims 8-11 are patentable over Shah, Kahn, Kasmperschroer, and any combination thereof, for *at least* these independent reasons. Thus, Appellant respectfully requests that the Board overturn the Examiner's rejections of claims 8-11.

VIII. CONCLUSION

In view of the foregoing differences between appealed claims 1-16 and Shah, Khan, Sipilä, Kasmperschroer and Heuvel, Appellant respectfully submits that the appealed claims are patentable over Shah, Khan, Sipilä, Kasmperschroer, Heuvel and any combination thereof..

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

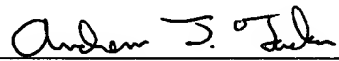
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Andrew J. Taska
Registration No. 54,666

Date: October 27, 2006

CLAIMS APPENDIX

CLAIMS 1-16 ARE ON APPEAL:

1. (previously presented): An automatic network services management method comprising:

connecting a communication terminal of a first network to a private base;

connecting said private base to a second network; and

a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network.
2. (previously presented): The method claimed in claim 1 wherein said correspondence memory is in said communication terminal.
3. (previously presented): The method claimed in claim 1 wherein said correspondence memory is in said private base.
4. (previously presented): The method claimed in claim 3 further comprising:

composing a request corresponding to a service from said communication terminal;

sending said request from said communication terminal and receiving said request at said private base;

updating said request in said private base as a function of said correspondence memory;
and
sending said request to said second network and receiving said request by an operator
managing said services of said second network.

5. (previously presented): The method claimed in claim 4 wherein, if said
correspondence memory contains no match to said request sent by said communication terminal,
said request is transmitted without formatting to an operator managing said services of said
second network.

6. (previously presented): The method claimed in claim 4 further comprising
receiving an acknowledgement at said communication terminal after processing of said request
by an operator managing said services of said second network.

7. (previously presented): The method claimed in claim 4 further comprising
receiving an acknowledgement at said private base after processing of said request by an
operator managing said services of said second network.

8. (previously presented): The method claimed in claim 1 wherein said
correspondence memory is updated during a call between said private base and an operator of
said second network.

9. (previously presented): The method claimed in claim 1 wherein said correspondence memory is updated during a call between said communication terminal and an operator of said first network.

10. (previously presented): The method claimed in claim 8 wherein said correspondence memory is updated automatically and periodically.

11. (previously presented): The method claimed in claim 8 wherein said updating is triggered by a user.

12. (previously presented): The method claimed in claim 1 wherein said first network is a mobile telephone network.

13. (previously presented): The method claimed in claim 1 wherein said second network is a terrestrial telephone network.

14. (previously presented): The method claimed in claim 1 wherein said mobile communication terminal is automatically connected to said private base when said terminal is within range of said base.

15. (previously presented): A communication terminal, adapted to implement an automatic network services management method, comprising:

a communication terminal of a first network;

a private base connected to a second network, wherein said communication terminal is connected to said private base; and

a memory structured to establish a correspondence between service codes of said first network and service codes of said second network.

16. (previously presented): A private base, adapted to implement an automatic network services management method, comprising:

a communication terminal of a first network;

a private base connected to a second network, wherein said communication terminal is connected to said private base; and

a memory structured to establish a correspondence between service codes of said first network and service codes of said second network.

Amended Appeal Brief under 37 C.F.R. § 41.37
U.S. Appl. No.: 09/918,501

Group Art Unit 2617
Attorney Docket #: Q65593

EVIDENCE APPENDIX:

This Appendix is not applicable to this Appeal.

Amended Appeal Brief under 37 C.F.R. § 41.37
U.S. Appl. No.: 09/918,501

Group Art Unit 2617
Attorney Docket #: Q65593

RELATED PROCEEDINGS APPENDIX

This Appendix is not applicable to this Appeal.